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I. Introduction

The Examiner's Answer mailed October 31, 2007 failed to rebut the points of clear error identified in Applicant's Appeal Brief. This Reply Brief addresses the specific arguments made in the Examiner's Answer.

II. Argument

A. The Examiner Erred in Rejecting Claims 1-11 and 18-21 as Being Obvious over a Combination of Mosher and Gourraud

In Section VII.A of the Appeal Brief, Applicant demonstrated that the Examiner's reliance on Gourraud to make up for the deficiencies in Mosher was clear error because: (1) Gourraud discloses a choice of programs, not a choice of transmission modes; (2) Gourraud does not disclose presenting the terminal with a set of choices that is tailored based on at least one presentation capability of the terminal; and (3) Gourraud does not disclose receiving a list of available media content, wherein all media content in the list of available media content is compatible with a user-selected transmission mode.

With respect to argument (1), the Examiner's Answer improperly attempts to equate a choice of programs with a choice of transmission modes based on conclusory assertions that are unsupported by any evidence of record. With respect to argument (2), the Examiner's Answer provides no evidence that the set of choices in Gourraud is in any way based on a presentation capability of the terminal. With respect to argument (3), the Examiner's Answer argues that the "user terminal must receive a list of media content" in Gourraud but provides no rationale for why all of the media content in the list would be compatible with a user-selected transmission mode. In addition, the Examiner's response to argument (1) is inconsistent with the Examiner's response to argument (3). These four points are discussed in detail below.

1. The Examiner's Answer improperly equates the choice of programs in Gourraud as a choice of transmission modes

The Examiner's Answer admits that what Gourraud discloses is actually a *program list*: "Gourraud discloses a program list including a plurality of selected programs, which are provided by a plurality of content providers." See Examiner's Answer, p. 11. In order to get from the *program list* disclosed in Gourraud to what claim 1 actually claims,¹ i.e., "a set of choices indicating *transmission modes* for streaming media content to the wireless handset," the Examiner's Answer argues that "it is reasonably interpreted a choice of programs as a choice of transmission mode." See Examiner's Answer, p. 12.

As the basis for this argument, the Examiner's Answers asserts that "[i]t is known in the art that the different media programs are required a different bandwidth transmission modes and/or as well as a different bit rate transmission modes (i.e., video streaming for video program is required a high bandwidth transmission mode and/or as well as a fast bit rate transmission mode; while audio streaming for audio program is required a low bandwidth transmission mode and/or as well as a slow bit rate transmission mode)." See Examiner's Answer, pp. 11-12. ***However, the Examiner's Answer cites absolutely no evidence in support of this assertion.*** Thus, the Examiner is attempting to rely on precisely the kind of conclusory assertion that the Supreme Court has made clear is insufficient to support a legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385, 1396 (S. Ct. 2007).

In addition, the Examiner's Answer improperly relies on teachings in Applicant's specification to support the Examiner's claim rejections. Specifically, the Examiner's Answer argues that "appellant specifies 'a transmission mode' as 'video only, audio only,'" citing to page

¹ Claims 18 and 19 include similar language.

9 of Applicant's specification. *See* Examiner's Answer, p. 11. This, however, is an egregious example of impermissible hindsight. The Supreme Court has warned against the hindsight temptation of reading into the prior art the teachings of the invention at issue. *KSR*, 82 USPQ2d at 1397. In this case, the Examiner's Answer has done just that by improperly relying on *Applicant's* teaching of a "video only" or "audio only" transmission mode, rather than on any *prior art* teaching of such transmission modes.

Moreover, Applicant has demonstrated that the actual relevance of Applicant's specification lies in its explicit definition of a "transmission mode" as "parameters used to send media content to the wireless handset." *See* Appeal Brief, pp. 8-9. As such, the fact that a particular implementation of Applicant's invention may allow for a "video only" or "audio only" transmission mode does not mean that a selection of a video or audio *program* is a selection of a *transmission mode*. *See* Appeal Brief, pp. 9-10.

Because the Examiner's rejections of claims 1-11 and 18-21 are based on improperly equating the choice of programs in Gourraud as a choice of transmission modes, the Examiner's rejections of those claims are clearly erroneous and should be reversed.

2. Gourraud does not disclose presenting the terminal with a set of choices that is based on a presentation capability of the terminal

Claims 1, 18, and 19 specify not only presenting a set of choices indicating transmission modes for streaming media content to the wireless handset but also specify that the set of choices is based at least in part on a *presentation capability* of the wireless handset. For example, claim 1 recites "wherein the set of choices [indicating transmission modes] is tailored based on at least one presentation capability of the wireless handset." However, even if the choice of programs in

Gourraud were to be viewed as a choice of transmission modes, Gourraud does not disclose that the set of choices is in any way based on a presentation capability of the user's terminal.

The Examiner's Answer does not provide any evidence to the contrary. In particular, the Examiner's Answer argues that "Gourraud discloses each of the content providers having at least one given type of media programs such as for example movies ('video' for 'view'), songs ('audio' for 'listen'), etc. (see [0013])." See Examiner's Answer, p. 11. However, this argument does not indicate that the choice of media programs offered by the content providers is in any way based on a presentation capability of the user's terminal. In fact, paragraph 13 of Gourraud discloses that "content providers each comprise at least one given type of media programs, such as for example movies, songs, news, movie previews, etc.," a statement that in no way suggests that the choice of media programs offered by the content providers is based on a presentation capability of the user's terminal.

The Examiner's Answer then argues that "the user can select the program to be viewed [0041] based on presentation capability of the terminal ('at least one', which is an alternative phrase." See Examiner's Answer, p. 11. This argument, however, is really that the *user* can select a program based on a presentation capability of the terminal, not that the set of choices *presented* to the user is based on a presentation capability of the terminal. In this regard, claim 1 recites "*presenting on the wireless handset* a set of choices ... wherein the set of choices is tailored based on at least one presentation capability of the wireless handset."² Thus, the

² Similarly, claim 18 recites logic to "*present on the screen display* a set of choices indicating available transmission modes ... wherein the available transmission modes are based at least in part on a presentation capability of the wireless handset" and claim 19 recites logic to "*send to the wireless handset* a set of choices indicating transmission modes ... wherein the set of choices indicating transmission modes is based, at least in part, on a presentation capability of the wireless handset."

Examiner's argument that the user in Gourraud can select a program based on presentation capability is irrelevant because it does not address the actual claim language. Moreover, paragraph 41 of Gourraud does not actually support the Examiner's proposition, because it does not describe a user selecting a program based on a ***presentation capability*** of the user's terminal. Instead, it describes a user selecting a program based on the user's viewing preferences. For example, "a user can get uninterested in a poorly acted movie ... desire to end the viewing of the movie and, optionally, go to the following one." *See* paragraph 41.

As discussed in Section VII.A.2 of the Appeal Brief, what Gourraud actually discloses is that the service provider can provide access to a wide range of media programs, some of which would be compatible with a "view" capability (e.g., "movies") and some of which would not be (e.g., "songs"). *See* paragraph 13 of Gourraud. Thus, the set of program choices presented to the terminal in Gourraud is not based on the terminal's presentation capability.

Because there is nothing in Gourraud that discloses a set of choices presented to the terminal wherein the set of choices is based on a presentation capability of the terminal, the Examiner's rejections of claims 1-11 and 18-21 are clearly erroneous and should be reversed.

3. Gourraud does not disclose receiving a list of available media content, wherein all media content in the list of available media content is compatible with a user-selected transmission mode

In addition to a set of choices indicating transmission modes, claims 1, 18, and 19 recite receiving a list of available media content, wherein all media content in the list of available media content is compatible with the indicated or selected transmission mode, i.e., a transmission mode that the user has selected from the set of choices indicating transmission modes.

For this element, the Examiner's Answer argues that "Gouraud describes that the user terminal sends a program list including a plurality of selected programs [0014]." *See* Examiner's Answer, p. 12. The Examiner is apparently referring to the first step in the method disclosed in paragraph 14 of Gouraud: "a) sending a program request to the service provider, the program request comprising a program list including a plurality of selected programs." However, claims 1, 18, and 19 specify that the wireless handset *receives*, not sends, the list of media content.³

Apparently recognizing this, the Examiner's Answer then reasons that "the user terminal must receive a list of media content, in order for the user terminal of capable in selecting one or more media contents then sending one or more selected media contents to the service provider." *See* Examiner's Answer, p. 12. Thus, the Examiner is arguing that the user terminal receives a list of available programs from the service provider (a step that is not disclosed in paragraph 14) *before* the user terminal sends the service provider a program request with a program list of selected programs (step "a" disclosed in paragraph 14).

However, this line of reasoning, even if it were to be accepted, would indicate only that the user receives a list of media content; it still does not indicate that all media content in the list is compatible with a user-selected transmission mode. Thus, the Examiner's Answer is fatally flawed because it provides no rationale for why all of the media content in a list of available media content from Gouraud's service provider would be compatible with a user-selected transmission mode.

³ Claim 1 recites "receiving a list of available media content, wherein all media content in the list ... is compatible with the indicated transmission mode." Claim 18 recites "selection logic ... (i) to receive from the media server a list of available media content, wherein all media content in the list of available media content is compatible with the selected transmission mode." Claim 19 recites "list logic ... to i) establish a list of available media content, wherein all media content in

Thus, the Examiner's rejections of claims 1-11 and 18-21 are clearly erroneous because Gourraud does not disclose receiving a list of available media content, wherein all media content in the list of available media content is compatible with a user-selected transmission mode.

4. The Examiner's rationale regarding "transmission modes" is inconsistent with the Examiner's rationale regarding "media content" compatible with a user-selected transmission mode

The reasoning on page 12 of the Examiner's Answer also indicates that the Examiner's rationale regarding Gourraud is internally inconsistent. As discussed above in Section II.A.1, the Examiner has improperly characterized Gourraud's choice of programs as a choice of transmission modes. However, if the Examiner's rationale were to be accepted, it would follow that the user selects a transmission mode by selecting a program. Thus, applying the Examiner's rationale, the user in Gourraud would select a transmission mode and a program *at the same time*.

However, that is not what is recited in claims 1, 18, and 19. As discussed above in Section II.A.3, the claims specify that the wireless handset receives a list of available media content wherein all media content in the list is compatible with a user-selected transmission mode. Thus, claims 1, 18, and 19 specify a sequence in which the user selects a transmission mode and then receives a list of media content that is compatible with the user-selected transmission mode. As a result, the Examiner's view that the user in Gourraud selects the transmission mode and the media content (i.e., the program) at the same time conflicts with the actual claim language.

the list is compatible with the indicated transmission mode, ii) to send the list to the wireless handset."

It also conflicts with the Examiner's rationale regarding the list of available media content, i.e., the rationale discussed above in Section II.A.3. In particular, the Examiner has argued that the list of available programs from Gourraud's service provider is a "list of available media contents wherein all media content in the list of available media content is compatible with a user-selected transmission mode." *See Examiner's Answer*, p. 12. However, the Examiner's own reasoning indicates that the user terminal would receive the list from the service provider *before* sending the service provider a request with a program list of selected programs. Because selection of a program is what selects a transmission mode (according to the Examiner's rationale discussed above in Section II.A.1), the list from the service provider -- before the user has selected any programs -- cannot possibly be a list of media content that is compatible with a user-selected transmission mode.

Therefore, the Examiner's rationale discussed above in Section II.A.1 (i.e., that a choice of programs is a choice of transmission modes) is inconsistent with the Examiner's rationale discussed above in Section II.A.3 (i.e., that the user receives from the service provider a list of programs compatible with a user-selected transmission mode so that the user can then select one or more programs). For this reason also, the Examiner's rejections of claims 1-11 and 18-21 are clearly erroneous and should be reversed.

B. The Examiner Erred in Rejecting Claim 22 as Being Obvious over a Combination of Mosher and Gourraud

In Section VII.B of the Appeal Brief, Applicant demonstrated that the Examiner's rejection of claim 22 is fatally flawed because Gourraud does not disclose "providing the user with a list of permissible transmission modes for the selected media content choice, wherein the list of permissible transmission modes is tailored to the presentation capabilities of the wireless

handset.” The Examiner’s Answer confirms that the Examiner is relying on Gourraud for this element. *See* Examiner’s Answer, p. 7. However, the Examiner’s Answer fails to rebut the four points of error identified in the Appeal Brief.

With respect to the first point of error, the Examiner’s Answer confirms that the rejection of claim 22 is premised on equating Gourraud’s program list as a list of permissible transmission modes. *See* Examiner’s Answer, p. 13 (“it is interpreted a program list as a list of permission transmission modes.”). However, as discussed above in Section II.A.1, the Examiner’s attempt to equate a choice of programs with a choice of transmission modes is improper.

As the second point of error, Applicant noted that even if program list 103 in Gourraud were somehow considered to be a list of permissible transmission modes, program list 103 would still not meet the claim requirement of “providing the *user* with the list of permissible transmission modes” because program list 103 is *created* by the user, not *provided* to the user. The Examiner’s Answer purports to address this second point of error. *See* Examiner’s Answer, pp. 12-13. However, the response still ignores the “providing the user” language in claim 22. In fact, the Examiner’s Answer mischaracterizes the claim limitation as “a list of permissible transmission modes that is tailored to the presentation capabilities of the wireless handset,” thereby omitting the troublesome “providing the user” language. *See* Examiner’s Answer, p. 13.

In fact, the Examiner’s Answer elsewhere admits that the program list (which the Examiner incorrectly characterizes as a list of transmission modes) is *sent* by the user terminal rather than *provided to* the user terminal. *See* Examiner’s Answer, p. 12 (“Gourraud describes that the user terminal sends a program list including a plurality of selected programs [0014] to a service provider.”).

As the third point of error, Applicant noted that claim 22 specifies that the list of permissible transmission modes is “for the selected media content choice,” whereas program list 103 is clearly a list of the selected media content choices themselves, not a list of different transmission modes for the same media content choice. *See* Appeal Brief, p. 15. The Examiner’s Answer does not appear to address this point.

As the fourth point of error, Applicant noted that if program list 103 were to be considered a list of permissible transmission modes, as the Examiner has, then what is the “selected media content choice” for which program list 103 is the list of permissible transmission modes? *See* Appeal Brief, p. 15. The Examiner’s Answer fails to answer that question. In fact, the Examiner’s Answer mischaracterizes the claim limitation as “a list of permissible transmission modes that is tailored to the presentation capabilities of the wireless handset,” thereby omitting the troublesome “selected media content choice” language. *See* Examiner’s Answer, p. 13.

Accordingly, the Examiner’s rejection of claim 22 is clearly erroneous for at least the foregoing reasons.

C. The Examiner Erred in Rejecting Claim 24 as Being Obvious over a Combination of Mosher, Gourraud, and Iida

Claim 24 depends from claim 22. As discussed above, the combination of Mosher and Gourraud fails to teach or suggest all of the limitations of claim 22. Iida does not make up for the deficiencies in the Mosher/Gourraud combination. Moreover, if an independent claim is nonobvious, then any claim depending therefrom is nonobvious. MPEP § 2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, the Examiner’s rejection of claim

24 is erroneous for at least the same reasons that the Examiner's rejection of claim 22 is erroneous.

D. The Examiner Erred in Rejecting Claim 25 as Being Obvious Over a Combination of Mosher, Gourraud, and Oishi

Claim 25 is dependent on claim 22. As discussed above, the combination of Mosher and Gourraud fails to teach or suggest all of the limitations of claim 22. Oishi does not make up for the deficiencies in the Mosher/Gourraud combination. Moreover, if an independent claim is nonobvious, then any claim depending therefrom is nonobvious. MPEP § 2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, the Examiner's rejection of claim 25 is erroneous for at least the same reasons that the Examiner's rejection of claim 22 is erroneous.

E. Conclusion

Applicant has demonstrated that the rejections of claims 1-11, 18-22, 24, and 25 are in error as a matter of law. Applicant therefore requests reversal of the rejections and allowance of all pending claims in this application.

Respectfully submitted,

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